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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,096	01/19/2001	Stephane Mallof	108407	4500

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EXAMINER
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THOMPSON, CAMIE S

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/03/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

42-13

# Office Action Summary

Application No.

09/764,096

Applicant(s)

MALLOL ET AL.

Examiner

Camie S Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 15-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

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### DETAILED ACTION

1. Applicant's amendment and accompanying remarks filed April 10, 2003 have been acknowledged.

### *Claim Rejections - 35 USC § 103*

2. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 103(a) as being obvious over Doublet et al., U.S. Patent Number 6,402,888.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or

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subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2). Doublet discloses a security sheet comprised of cellulose fibers wherein the paper includes localized areas with reduced thickness and opacity in areas determined as watermarks as per instant claim 1 (see column 1, lines 9-21). Also, the reference discloses that an image is obtained when the paper is observed by transmitted light as per instant claim 1 (see column 1, lines 36-54). Doublet discloses that there are differences in the density of the paper particularly by means of the watermark and that the darker areas have a fiber density greater than the light areas as per instant claim 2 (column 1, lines 36-54). Column 2, lines 8-30 of the reference disclose that the lighter areas of the paper have a surface area less than  $0.4 \text{ cm}^2$  as per instant claim 4. In addition, Doublet discloses that the area of reduced opacity can include colored pigments, fluorescent or luminescent pigments as per instant claim 5 (see column 3, lines 38-43).

3. Claims 1-2 and 4-5 are directed to an invention not patentably distinct from claims 9, 11, 13 and 18 of commonly assigned invention. Specifically, claims 9 and 11 disclose a sheet of security paper, which has at least one area of reduced opacity wherein the sheet, is in the form of a banknote. A banknote is known to have portraits or images or persons.

### ***Double Patenting***

4. Claims 1-2 and 4-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-11, 13, 17, 18 and 20 of U.S. Patent No. 6,402,888. Although the conflicting claims are not identical, they are not patentably distinct

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from each other because the Doublet reference discloses a security sheet comprised of cellulose fibers wherein the paper includes localized areas with reduced thickness and opacity in areas determined as watermarks. The reference also discloses that the areas of reduced opacity can include colored pigments, fluorescent pigments or luminescent pigments. Doublet also discloses that the security paper has an area of reduced opacity of at least  $0.4 \text{ cm}^2$ .

5. Claims 1, 3 and 15-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-11, 13, 17-18 and 20 of U.S. Patent No. 6,402,888 in view of Fedrigoni et al., U.S. Patent Number 5,916,416. Doublet reference discloses a security sheet comprised of cellulose fibers wherein the paper includes localized areas with reduced thickness and opacity in areas determined as watermarks. The reference also discloses that the areas of reduced opacity can include colored pigments, fluorescent pigments or luminescent pigments. Doublet also discloses that the security paper has an area of reduced opacity of at least  $0.4 \text{ cm}^2$ . Fedrigoni teaches a cellulose fiber paper which has a plurality of watermarks (see column 1, lines 14-50). In addition, Fedrigoni teaches that a dark grey paper affected by parallel line approximately 1.2-1.3 mm wide were significantly lighter in color giving a pinstripe appearance as per instant claim 3 (see column 2, lines 57-60). Fedrigoni does not teach that the lines constitute 50% of the screen marks as per instant claim 15. The number of lines reduces the risk of falsification of the paper and is used as an additional security measures. However, this feature is optimizable. Discovery of optimum values of result effective variables involves only routine skill in the art in re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA). Therefore, it would have been obvious to one of ordinary skill in the art to have 50%

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of the screen marks constitute lines in order to provide an additional security measure and reduce the risk of falsification.

Although Fedrigoni teaches that the lines are approximately 1.2-1.3 mm wide, the reference does not teach that the pitch lies in the range of five lines per centimeter to 20 lines per centimeter.

The number of lines adds to the originality of the watermark and the paper, thereby, creating an additional security feature. However, this feature is optimizable. Discovery of optimum values of result effective variables involves only routine skill in the art in re Boesch, 617 F2. 2d 272, 205 USPQ 215 (CCPA). Therefore, it would have been obvious to one of ordinary skill in the art to have the pitch in the range of five lines per centimeter to 20 lines per centimeter in order to provide originality to the watermark.

Neither reference teaches the amplitude modulation, the frequency modulation or the inclination of the lines in the screened image as per instant claims 16, 18 and 19. The screened image of a paper is going to have an amplitude modification and a frequency modification, as these are physical properties of the screened image. Therefore, these features are inherent.

The inclination of the lines is used as an additional security measure to prevent falsification.

However, this feature is optimizable. Discovery of optimum values of result effective variables involves only routine skill in the art in re Boesch, 617 F2. 2d 272, 205 USPQ 215 (CCPA).

Therefore, it would have been obvious to one of ordinary skill in the art to have the lines inclined at 45° in order to provide for additional security to prevent falsification.

*Response to Arguments*

6. Applicant's arguments filed April 10, 2003 have been fully considered but they are not persuasive. Applicant argues that the Doublet reference does not disclose that the watermark has a set of pale zones arranged in the manner of a screened image. The reference discloses that the sheet made of paper can include a hologram in an area of reduced opacity. A hologram is defined as a three-dimensional image formed by the interference of light beams from a coherent light source. Additionally, the reference discloses that the area of reduced opacity can receive any other distinctive mark (see column 3, lines 17-20). Other distinctive marks can include shaped dots that result from a screening process. Therefore, the reference includes screen images in the area of pale zones just as the instantly claimed invention.

Applicant's statement is not a showing that the Doublet invention was assigned to the same assignee as the applicant at the time the instant invention was made. Applicant must submit a declaration demonstrating that the instantly claimed application was made at the same time the Doublet invention was assigned to the same assignee.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (703) 305-4488. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached at (703) 308-0449. The fax phone numbers for the Group are (703) 872-9310 {before finals} and (703) 872-9311 {after finals}.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

